

REMARKS/ARGUMENTS

This submission accompanies an RCE and serves as a response to the Final Office Action of December 1, 2006 issued in connection with the instant application.

Because the Office Action makes no rejection of claims 41 or 43 on any ground, Applicant presumes that these are allowable, and kindly requests an indication of the same in the next Official Action.

Rejection under 35 U.S.C. 112

Claims 3 and 39 are rejected under 35 U.S.C. 112, second paragraph as indefinite for use of the term “animation”. Applicant respectfully traverses the rejection.

In the Response to Arguments at p. 28, the Final Office Action (FOA) states that the Applicant has not clarified the meaning of the term “animation”, because no specific definition of the term appears in the Specification. However, Applicant is under no such obligation to define each and every term used in the claims. “The specification would be of enormous and unnecessary length if one had to literally reinvent and describe the wheel.” *Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374, 53 USPQ2d 1225 (Fed. Cir. 1999).

The controlling law is clear that there is a presumption that claim terms are to be given their ordinary customary meaning *unless*, acting as his or her own lexicographer, Applicant has clearly set forth a definition of the term different from its ordinary and customary meaning. *ACTV, Inc. v. Walt Disney Co.*, 346 F.3d 1082, 1091, 68 USPQ2d 1516 (Fed. Cir. 2003). The Office Action turns this presumption on its head, and asserts that because Applicant has not acted as his own lexicographer to define the term, the claims are somehow deficient. There is no support for that position.

The standard to be applied is whether the claim would apprise one of ordinary skill in the art of its scope. “If the claims read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, Section 112 demands no more.” *Solomon v. Kimberly-Clark Corp.*, 16 F.3d 1372, 55 USPQ2d 1279, 1282 (Fed. Cir. 2000). Applicant has specifically not attempted to redefine the term through argument, but simply used the term as it would be used by one of ordinary skill in the art, and it should be given that meaning that one of ordinary

skill in the art would give it. Applicant's previous response merely cited to certain guidance that a reasonable person of ordinary skill in the art could consult if such a person were for some unlikely reason unclear of the scope of the claim term. Applicant kindly requests favorable reconsideration and withdrawal of the rejection.

Rejection under 35 U.S.C. 102

Claims 3, 5-6, 10, 17-18, 21, 23-24, 28, 35-36, 39, 42, 46 and 53-54 are rejected under §102(e) as anticipated by U.S. Patent No. 6,892,354 to Servan-Schreiber, *et al.*, ("Servan"). Applicant respectfully traverses the rejection. In view of the rejection being copied nearly verbatim from the previous Office Action, Applicant's comments directed to the Response to Arguments of the FOA, p. 28.

Claims 3, 21 and 39 each include structure for or a method step of reproducing or showing advertisements by animation. The Office Action asserts that Applicant is arguing limitations not in the claims where Applicant pointed out that Servan "Does not teach or suggest display of an advertisement by animation, a moving picture, or any analogous concept." (Response filed Sept 14, 2006, p. 16) The Office Action observes that the claims do not recite 'a moving picture or any analogous concept'.

The point being made was not that the claims recite 'a moving picture or any analogous concept'. Rather, the point being made was that a moving picture, or any concept analogous to a moving picture, is a broader concept than just animation. If Servan had taught any of these, it might be applicable to the present claims. However, Servan does not teach or suggest the broader concept of a moving picture, or any concept analogous to a moving picture. Neither does Servan teach or suggest displaying of an advertisement by animation, which would be a narrower teaching included within a moving picture, and which is explicitly recited in the claims. The Office Action itself acknowledges that Servan does not teach or suggest animation, because it goes on to rely upon Official Notice for this feature of the claims (FOA, p. 29).

It is well settled in the law that "Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Company et al.*, 730 F.2d

1452, 221 USPQ 481 (Fed. Cir., 1984). Therefore, in light of the fact that Sevran does not teach display of an advertisement by Animation, as evidenced by the fact that the Office Action needed resort to Official Notice for this element of the claims, Applicant respectfully submits that the rejection is poorly taken, and kindly requests favorable reconsideration and withdrawal.

Rejection under 35 U.S.C. 103

Claims 3-4, 7, 11-16, 21-22, 25, 29-34, 39-40 and 47-50 are rejected under 35 U.S.C. §103(a) as obvious over Servan in view of Official Notice, which is to say Servan alone. Applicant respectfully traverses the rejection.

Applicant respectfully submits that claim 4 as amended is patentable over both the evidence of record, and the FOA's allegations of Official Notice. Independent claim 4, and its dependent claims by reference, are amended to recite

 said personal history information comprises:

 purchasing history; or

 reply history information for questions.

The Office Action cites Servan Col. 4, lines 48-60 as a teaching of advertisement access history as the personal history information upon which the selection of advertisements is based.

Notwithstanding the merits of Servan on this point, Servan does not teach or suggest the selection of advertisements for display based upon personal history information comprising purchasing history or reply history information for questions. Therefore, Applicant respectfully submits that claim 4, and by reference claim 6 which is dependent upon claim 4, are patentable. Favorable reconsideration and withdrawal of the rejection of claims 4 and 6 is kindly requested.

Applicant's further comments are directed to the Response to Arguments of the FOA, p. 31. The final rejection again relies extensively upon Official Notice of facts not supported by evidence of record. Specifically, the Office Action takes Official Notice of no less than eight features across twenty-one claims, including

- “Official Notice is taken that it is old and well known to animate advertisements especially on webpages by imparting motion or activity to a graphic by using things such as blinking,

- having advertisements float across the monitor, having pop-op [sic] advertisements, and changing colors used in advertisements.” FOA, p. 11, 18, 25.
- “Official Notice is taken that it is old and well known to store personal history information in the field of advertising to target advertisements based on personal history information.” FOA, p. 12, 19, 25.
 - “Official Notice is taken that is old and well known to present content in different formats based on the user's environment.” FOA, p. 13, 19.
 - “Official Notice is taken that is old and well known to present advertising content while uploading data to a server via a network...” FOA, p. 14, 20, 26.
 - “Official Notice is taken that it is old and well known to store response input information in the field of e-commerce.” FOA, p. 15, 21, 27.
 - “Official Notice is taken that it is old and well known to access and retrieve responses stored in a response storage section in the field of advertising.” FOA, p. 15, 22, 27.
 - “Official Notice is taken that it is old and well known to execute sales of products or services to said user while data is transferred to or from said server via said network.” FOA, p. 16, 23 (emphasis added).
 - “Official Notice is taken that it is old and well known to perform a virus check on the user side equipment while data is transferred to or from said server via said network.” FOA, p. 17, 24 (emphasis added).

These statements of Official Notice are the only evidence offered against significant portions of most independent claims, and the against the entirety of the substantive features of several dependent claims. The Office Action’s use of the term “said” is emphasized because it is not necessary to the factual allegation being made, since there is no prior recitation of “a server” in the allegation of Notice. The use of “said” in the context of the FOA, imitating the language of the claims while setting forth what is allegedly ‘old and well known’, manifests the hindsight bias to reject the claims, despite the absence of evidence supporting the rejection.

Applicant kindly directs the Examiner’s attention to M.P.E.P. § 2144.03, which addresses the use of Official Notice. Specifically, the M.P.E.P. states that Official Notice may be appropriate in limited circumstances, to “fill in the gaps” in the evidentiary showing. As used in

the FOA, it is more accurate to say that the references are used to fill the gaps in the Official Notice.

The M.P.E.P states that in response to a challenge of a factual assertion made by Official Notice, “[T]he Examiner **Must** Support the Finding with Adequate Evidence” M.P.E.P. § 2144.03 (C) (emphasis added). The only requirements of a challenge to the taking of Official Notice are that it be reasonable, i.e. timely, which Applicant was by challenging the Official Notice in Applicant’s first response after which it was first taken. The M.P.E.P. further states that the challenge must be directed specifically to the taking of Official Notice, and by contrast only a general allegation that the claims are patentable is insufficient to contest the Official Notice. *Id.* In this case, Applicant did specifically challenge the taking of Official Notice. See, Response filed Sept 14, 2006, p. 17; FOA, p. 31.

There is no support in the M.P.E.P. for the position taken in the FOA that Applicant’s burden is to challenge the substance of the factual allegation taken by Official Notice. Neither is it correct that by taking Official Notice, the burden of proof as to the patentability of the claims is reversed, obligating the Applicant to disprove the facts alleged by Notice. Even if some misinterpretation of the M.P.E.P. could lead to that conclusion, controlling law to the contrary overrides inconsistent statements of the M.P.E.P. *In re Recreative Technologies Corp.*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996) (“[W]hen a section of the M.P.E.P. is inconsistent with the statute it must yield ...”). In cases such as this, the courts have reversed the Board of Patent Appeals and Interferences, and held that a rejection based solely upon “basic knowledge and common sense was not based on any evidence in the record and, therefore, lacks substantial evidence support.” *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001), *on remand from Dickinson v. Zurko*, 527 U.S. 150, 50 USPQ2d 1930 (1999). See also, *In re Lee*, 277 F.3d 1338, 1341, 1345, 61 USPQ2d 1430 (Fed. Cir. 2002). Citing, *Zurko*, the M.P.E.P. concludes “It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based.” M.P.E.P. § 2144.03 (E).

In light of the foregoing, Applicant respectfully submits that the final rejections based on Official Notice, unsubstantiated in the face of Applicant’s reasonable challenge, are poorly taken, and kindly requests favorable reconsideration and withdrawal. If the statements of Official Notice

are drawn from Examiner's personal knowledge, an affidavit or declaration pursuant to 37 C.F.R. §104(d)(2). M.P.E.P. §2144.03(E).

Conclusion

Favorable consideration of the application is earnestly solicited.

Respectfully submitted,

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